

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE DIRECTOR

PALO ALTO NETWORKS, INC., CISCO SYSTEMS, INC., and KEYSIGHT
TECHNOLOGIES, INC.,
Petitioners,

v.

CENTRIPETAL NETWORKS, LLC,
Patent Owner.

IPR2022-00182
Patent No. 9,917,856 B2

**AUTHORIZED RESPONSE TO
DIRECTOR REVIEW REQUEST**

I. INTRODUCTION

Patent Owner’s Request for Director Review (“Request”) misinterprets the Federal Circuit’s remand of this case back to the Office. The Federal Circuit vacated the original Final Written Decision because that decision “failed to properly consider evidence of copying,” and so it “remand[ed] for the Board to conduct the proper analysis in the first instance.” CAFC Decision (Paper 72), 19-20. As to everything else Patent Owner had appealed, including the recusal challenge and other “purported deficiencies with the Board’s decision on the merits,” the court found no basis for relief. CAFC Decision, 6. The Board on remand did precisely what the mandate required: it evaluated every item of alleged copying evidence and issued a new Final Written Decision (“Remand FWD”), which again found claims 1, 24, and 25 unpatentable. Paper 78, 2, 42-43.

The Request says little about the remand panel’s evaluation of the alleged copying evidence, seeking instead to recast the Federal Circuit’s limited remand as a requirement to relitigate the entire proceeding. Patent Owner revives two arguments—concerning the “filtering” limitation and the term “URI”—that were decided against it in the original Final Written Decision and undisturbed on appeal. These arguments not only lack merit but are precluded by the mandate rule.

The mandate rule defines both what a remand *directs* and what it *forecloses*. Under *Intellectual Pixels Ltd. v. Sony Interactive Entertainment LLC*, No. 2024-

2174 (Fed. Cir. July 10, 2026), a tribunal must carry out an appellate court’s instructions. But a tribunal may *not* revisit findings that formed the basis of the appealed judgment and were left undisturbed on appeal. *Intellectual Pixels*, 12-13.

Here, the Federal Circuit remanded this case for the Board to consider the alleged evidence of copying. The court left the remainder of the Board’s original Final Written Decision undisturbed, including the “filtering” and “URI” issues. The “filtering” and “URI” issues formed the basis of the underlying unpatentability determination, were briefed at the Federal Circuit, and left undisturbed. *See* Brief for Appellant at 40-54, *Centripetal Networks, LLC v. Palo Alto Networks, Inc.*, No. 23-2027, Doc. 32 (Fed. Cir.) (“Appellant’s Br.”). The Board correctly declined to reopen them, and at the very least, was not *compelled* to do so.

Even if the Director were to reconsider these already-appealed issues, no intervention is warranted. Both issues were addressed in the Petition, litigated through trial, and correctly decided by both panels. Patent Owner’s procedural complaints likewise provide no basis for relief. The Director already denied de-institution and ordered a new panel. Director Order (Paper 75), 4; Panel Change Order (Paper 77), 2. Patent Owner’s Request should be denied.

II. BACKGROUND

The challenged claims of the ’856 patent have now been examined by two separate PTAB panels. Both panels reached the same conclusion of

unpatentability. Palo Alto Networks, later joined by Cisco and Keysight, petitioned for inter partes review of claims 1, 24, and 25, asserting obviousness over Buruganahalli. After a complete trial, the original panel issued a Final Written Decision on May 23, 2023, holding all challenged claims unpatentable over Buruganahalli. Original FWD (Paper 67). That decision resolved every disputed limitation against Patent Owner, including the “filtering” and “URI” limitations that Patent Owner now seeks to relitigate.

On appeal, Patent Owner argued that the Board judges were tainted by conflicts at the institution phase and “raise[d] a number of purported deficiencies with the Board’s decision on the merits.” CAFC Decision, 6. The Federal Circuit rejected the complaints about the Board judges, finding “no reversible error in the Board’s recusal analysis.” CAFC Decision, 3, 6-20.

The court then “[t]urn[ed] to the merits of the appeal” and identified a single, discrete error: the panel “did not discuss” the specific copying evidence and had wrongly declared itself “not in a position to evaluate the entirety of the litigation record.” CAFC Decision, 19. The court held the Board “had an obligation to consider the specific evidence that was put before it,” and, “[b]ecause the Board failed to properly consider evidence of copying, we vacate and remand for the Board to conduct the proper analysis in the first instance.” CAFC Decision, 19-20. Although Patent Owner had also raised arguments about the “filtering” and “URI”

limitations, the court remanded only for the alleged copying issue. The Federal Circuit’s opinion concluded: “We vacate the Board’s final written decision and remand to the Board for further proceedings consistent with this opinion.” *Id.*, 20 (citation and footnote omitted). On remand, the new panel recognized that “[t]he sole issue on remand is whether ‘the evidence of copying’ is sufficient to overcome the obviousness ground of unpatentability over Buruganahalli,” considered every item of copying evidence, and found it outweighed by a strong case of obviousness. Remand FWD, 4, 39-42.

III. LEGAL STANDARD

The mandate rule exists to prevent the relitigation of issues on remand that an appellate court left undisturbed. The mandate rule has two components. First, it directs what the Board *must* do on remand: carry out the appellate court’s instructions and conform to its decision. A tribunal “has no power or authority to deviate from the mandate issued [to it] by an appellate court.” *Intellectual Pixels*, 7 (quoting *Briggs v. Pa. Ry. Co.*, 334 U.S. 304, 306 (1948)).

Second, the mandate rule explains what the Board *may not* do on remand, namely, relitigate issues that formed the basis of the underlying judgment and were left undisturbed on appeal. As the Federal Circuit has explained, “all issues within the scope of the appealed judgment are deemed incorporated within the mandate and thus are precluded from further adjudication.” *Intellectual Pixels*, 7 (quoting

Engel Indus., Inc. v. Lockformer Co., 166 F.3d 1379, 1383 (Fed. Cir. 1999)).

Critically, the mandate rule precludes relitigation of not only those issues discussed in the appellate opinion, but also all issues within the scope of the appealed judgment, which are “deemed incorporated within the mandate” by operation of law. *Intellectual Pixels*, 7. Findings that were “within the scope of the first appealed judgment” and “were the basis of the [Board’s] conclusion” cannot be reopened on remand. *Id.* 12-13 (quoting *Bitmanagement Software GmbH v. United States*, 124 F.4th 1368, 1377 (Fed. Cir. 2025)).

IV. ARGUMENT

A. The Board Correctly Limited its Remand Review to the Copying Issue as the Federal Circuit Directed.

The Board correctly read and followed the Federal Circuit’s narrow mandate to “conduct the proper analysis” of the alleged copying evidence “in the first instance.” CAFC Decision, 19-20. The Director’s order confirms that reading, describing the remand as required because the Board “failed to properly consider evidence of copying.” Director Order, 2-3.

Patent Owner’s contrary theory—that vacatur “in its entirety” reopened “[e]very *Graham* factor and all merits issues”—misapprehends the mandate rule. Request, 4-7. Remand scope turns not only on an appellate court’s wording (e.g., “vacate”), but also on what the lower tribunal “actually decided” and what was “necessary to [its] disposition.” *Intellectual Pixels*, 7. Vacatur does not reopen

every issue. *Id.* at 9-11. When the Federal Circuit vacates a judgment but leaves some underlying findings undisturbed, those underlying findings cannot be reopened during remand proceedings. *Bitmanagement*, 124 F.4th at 1377.

The Board’s original URI and filtering findings cannot be revisited during this remand. First, both findings were necessary to the original unpatentability judgment: the Board held that Buruganahalli disclosed the disputed “filtering” limitation and that Buruganahalli’s “domain name” taught the claimed “URI.” Original FWD, 43-44. Second, both findings were undisturbed on appeal. While Patent Owner raised URI and filtering arguments in its appeal (Appellant’s Br. 47-54), the Federal Circuit identified no error in the Original FWD’s treatment of those limitations and left its findings undisturbed. CAFC Decision, 6, 19-20.

And regardless of whether the Federal Circuit explicitly discussed the filtering and URI findings, the mandate rule “precludes reconsideration of any issue within the scope of the judgment appealed from—not merely those issues actually raised.” *Amado v. Microsoft Corp.*, 517 F.3d 1353, 1360 (Fed. Cir. 2008). Its reach is “measured by the scope of ***the judgment appealed from***, not by the arguments advanced by the appellant.” *Engel*, 166 F.3d at 1382-83 (emphasis added). Because the filtering and URI findings formed the basis of the Original FWD’s judgment and the Federal Circuit did not disturb them, further argument on those findings is foreclosed—regardless of whether the appellate opinion addressed

them. *Tronzo v. Biomet, Inc.*, 236 F.3d 1342, 1349 (Fed. Cir. 2001) (issues “within the scope of the initial judgment” are “foreclosed from further review on remand”).

B. The Board Complied With the Mandate by Considering and Weighing the Copying Evidence.

The Board on remand did exactly what the mandate required. It considered each item of copying evidence Patent Owner cited—the vacated district court opinion, Striegel testimony, two Rogers examinations, and Cole redirect—and explained why each showed, at most, opportunity rather than actual copying. Remand FWD, 39-42. It then weighed the evidence overall—including Petitioners’ strong, “essentially anticipatory” obviousness case—and found the claims unpatentable. Remand FWD, 35, 42.

Patent Owner’s claim that the Board considered copying “in isolation” or “prejudged” the result therefore misreads the decision. Request, 7-8. The Board weighed evidence of copying against evidence of obviousness and concluded that the obviousness showing prevailed. The separate weighing of copying and industry praise in APJ Murphy’s concurrence confirms that the panel engaged with the evidence. Remand FWD, 35; Concurrence 1-4. The mandate required consideration and weighing. The Board provided both.

C. Patent Owner Misreads *Engel* and the Cited Director Order.

Patent Owner contends that *Engel* (relied on by the Remand Panel) is “inapposite” because it operates only on “issues within an affirmed judgment,” and

that a full vacatur leaves no “scope of the appealed judgment” to incorporate.

Request, 5-6. That is incorrect. *Intellectual Pixels* applied the mandate rule to a case that, like this one, involved vacatur and remand—yet still required the Federal Circuit to analyze which issues were within and outside the mandate’s scope.

Intellectual Pixels, 4-5. If vacatur automatically reopened everything, as Patent Owner suggests, the analysis in *Intellectual Pixels* would have been unnecessary.

Patent Owner’s reliance on the Director’s order in *Facebook v. Express Mobile* is also misplaced. Request, 6. In *Facebook*, the Federal Circuit vacated a final written decision, and the Board concluded on remand that the challenged claims were unpatentable. *Facebook Inc. v. Express Mobile, Inc.*, IPR2021-01226, Paper 65, 2-3 (May 1, 2026). On review, the Director explained that the Federal Circuit’s vacatur “did not require the Board to ignore intervening adjudications from other tribunals.” *Id.* at 3-4. That case, which involved an intervening jury verdict after vacatur, is wholly inapposite.

In any event, Patent Owner’s arguments cannot displace the Federal Circuit’s recent controlling articulation of the mandate rule in *Intellectual Pixels*, which forecloses attempts to relitigate issues that formed the basis of the original judgment, were appealed, and were left undisturbed. *See Intellectual Pixels*, 6-7. Here, the Federal Circuit’s opinion explicitly identified the reason for remand: “[b]ecause the Board failed to properly consider evidence of copying.” CAFC

Decision, 19-20. No other meaningful error was identified. *Id.*, 6. The Board honored both the letter and the spirit of its mandate.

D. Incorporating the Prior Merits Analysis Is Compliance, Not Error.

Patent Owner’s premise that the Board “effectively reinstated” the vacated decision and refused a “fresh look” mistakes compliance with the mandate for defiance of it. Request, 4-5. The mandate directed the Board to consider the purported copying evidence and precluded (and certainly did not *compel*) revisiting the filtering and URI findings that formed the basis of the Original FWD. It was not a “reinstatement” to follow the Federal Circuit’s affirmative directive and respect the mandate rule’s operation.

A newly constituted panel issued a new, complete Final Written Decision with an item-by-item analysis of the copying evidence. Remand FWD, 39-42. On the issues the mandate precluded from relitigation, the panel correctly treated the prior findings as settled and incorporated them. That the panel, having reconsidered the record, ultimately reached the same result does not make its decision a reinstatement; it makes it a reasoned decision that complied with both components of the mandate. And that certainly is “consistent with” the Federal Circuit’s opinion. CAFC Decision, 20.

Patent Owner’s argument reduces to the proposition that a remand panel must reach a different result to prove it gave the case a fresh look. The mandate

rule imposes no such requirement. It requires the tribunal to follow the appellate court's instructions and to respect the preclusive effect of the undisturbed aspects of the prior judgment. The Board did both.

E. Patent Owner's Filtering-Limitation Argument Is Both Precluded by the Mandate and Meritless.

Patent Owner's contention that the "filtering" finding rests on an unbriefed, *sua sponte* "prosecution history theory" fails at two levels. Request, 9-11.

First, the filtering challenge is outside the mandate. The original Final Written Decision found that Buruganahalli teaches the filtering limitation, and that finding formed part of the basis for the unpatentability judgment. Original FWD, 41-47. Patent Owner previously presented the same APA theory before the original panel, which rejected the argument because "the Petitions clearly identify the hello message theory of filtering" and "[t]he Board did not raise this theory on its own." Original FWD, 55-57. Patent Owner then renewed the issue on appeal as an APA and due-process challenge, but the Federal Circuit left the finding undisturbed. Appellant's Br. 40-44; CAFC Decision, 6. That settled issue is not open for relitigation on a remand limited to the alleged copying evidence. *Intellectual Pixels*, 12-13.

Second, the argument mischaracterizes what the Board did and identifies no impropriety. Patent Owner itself put the scope and operation of the "filtering" limitation directly in issue, arguing that the '856 patent filters encrypted packets

without decryption and that Buruganahalli therefore does not practice the limitation. Patent Owner Response, 5-8; Original FWD, 22-23, 43. In response, the Board focused on the claim language, which does not require applying packet-filtering rules *directly* to encrypted packets, but merely filtering those packets “*based on*” one or more specified rules. Remand FWD, 26, 28, 33. The Board also discussed how the examiner’s amendment further supported its understanding of the claims’ ordinary meaning. Consulting the intrinsic prosecution history, the Board explained that the claimed filtering criteria were carried into the claim from the patent’s step 22, and that those criteria read on Buruganahalli’s extraction of a domain name from the unencrypted hello message. Original FWD, 22-23, 44. Using prosecution history to further support the claims’ ordinary meaning and to test Patent Owner’s own distinction is ordinary claim analysis, not a freestanding, unbriefed ground of unpatentability. A tribunal does not violate the APA by resolving a dispute partly by consulting the patent’s prosecution history.

Critically, the operative unpatentability finding over Buruganahalli rested on Petitioners’ theory, not one the Board devised. The Petition mapped the filtering limitation to Buruganahalli’s domain-based policy: “The system applies a security rule based on the destination domain extracted from the request to ‘filter traffic.’” Petition, 35, 38-39. The Petition also explained that encrypted packets are “filtered after a determination that a handshake message that initiates the session includes

data that corresponds to the network threat indicator.” Petition, 35, 38-39.

Petitioner’s Reply reiterated the same theory. Petitioner Reply, 2-3. The Board determined that this disclosure in Buruganahalli satisfied the plain language of the claims, which was broad enough to cover indirect application of packet-filtering rules to encrypted packets. Remand FWD, 28. The prosecution-history discussion merely provides additional support for the Board’s rejection of Patent Owner’s argument—not a substitute unpatentability theory of the Board’s own creation.

Patent Owner’s reliance on the Reply’s “unclaimed extra step” footnote is also a mischaracterization. That footnote addressed a narrow point: that the claims “do not prohibit the unclaimed extra step of decryption after filtering of encrypted traffic,” and that “[t]his same unclaimed extra step—additional decryption at the proxy after filtering ... is also described in the ’856 specification.” Petitioner Reply, 1-2 & n.1. Petitioners consistently maintained that Buruganahalli performs the claimed filtering via the hello-message/domain-name theory before any decryption. Petitioner Reply, 3-7. The footnote is thus fully consistent with the Board’s rationale, not contrary to it. The filtering challenge thus fails on the merits.

F. Patent Owner’s URI Argument Fails: It Was Briefed, Litigated, and Correctly Resolved Against Patent Owner.

Patent Owner’s URI argument—that the Board’s construction was “raised by Petitioner for the first time at the Oral Hearing” and adopted *sua sponte* in violation of the APA—is likewise contradicted by the record and foreclosed from

relitigation on remand. Request, 12-14.

The URI theory was in the Petition. Petitioners argued that Buruganahalli filters “based on identifiers for a ‘domain’ (e.g., ‘uniform resource locator (URL)’)” and that “URLs are examples of **uniform resource identifiers**,” citing Magee (Ex. 1037). Petition, 35-36. At oral hearing, Petitioners confirmed that “filtering based upon a number of options there, the first one being the URI” and that “URI is a superset that includes a URL.” Hearing Tr., 12-13, 48. Petitioners “showed throughout the record that the filtering here is based upon a URL,” pointing to disclosures “discussed in the record in the petition and also in the reply.” Hearing Tr., 48. The relationship among domain name, URL, and URI was therefore at issue from the start. It was not a new theory sprung on the panel at argument.

In contrast, the Board found that Patent Owner attempted to raise a genuinely new argument at oral hearing—that “there is no URI (or URL) in Buruganahalli’s handshake message”—and accordingly held it waived. Original FWD, 43; Hearing Tr., 58-59. Patent Owner had not disputed that Buruganahalli taught filtering based on a URI in any of its submissions prior to the oral hearing.¹

¹ The Petition also identified additional unpatentability theories the Board did not reach, such as “filtering ... based on ... data indicating a request.” Petition, 34-37.

This is likely because, as Petitioners explained to the Federal Circuit, Centripetal’s infringement argument in the district court asserted that filtering by domain name (as disclosed in Buruganahalli) was the same as filtering by URI. Brief for Appellees at 12-13, 60, *Centripetal Networks, LLC v. Palo Alto Networks, Inc.*, No. 23-2027, Doc. 40 (Fed. Cir.).

But the Board did not rest on waiver; it also rejected the argument on the merits, holding that even “if it had been raised earlier” it “would be unpersuasive,” because no party had sought a construction of “URI” and “the plain language would encompass domain names, which are a ‘uniform’ way of ‘identifying’ a ‘resource.’” Original FWD, 43-44. Because the Board reached the merits, any purported waiver error caused no prejudice and does not warrant Director review.

And as with the filtering issue, the URI determination is not an overlooked APA defect, but an issue Patent Owner already raised and lost. Patent Owner presented the URI point to the Board at the oral hearing, and the Board both found it waived and rejected it on the merits. Original FWD, 44; Hearing Tr., 58-59. Patent Owner then renewed the challenge at the Federal Circuit as a *sua sponte* construction adopted without notice in violation of the APA, contending that the Board “may not adopt a claim construction in its final written decision that neither party requested nor anticipated” without “notice and opportunity for the parties to respond.” Appellant’s Br. 50-53. The court left the URI determination undisturbed.

The URI determination formed part of the original judgment, was presented on appeal, and was left standing—placing it outside the scope of remand and incorporating it into the mandate by operation of law. *Intellectual Pixels*, 8, 12-13.

G. SOP-3 Provides No Basis for Relief

Patent Owner’s procedural grievances do not warrant review. As Patent Owner concedes, SOP-3 does not “create any legally enforceable rights.” Request, 9. In any event, Patent Owner obtained the relief SOP-3 contemplates on the issue it now raises: the composition and scope of the remand were addressed by the Director, who denied de-institution and ordered a new panel. Director Order, 3-4. That new panel (Judges Turner, Murphy, and Hoffman) issued the Remand FWD. Panel Change Order, 2; Remand FWD, 1. The Federal Circuit’s suggestion that the Director “consider whether to assign this case to new APJs” was thus fully honored. CAFC Decision, 20; Director Order, 4. There is no prejudice to remedy.

V. CONCLUSION

The Director should decline Patent Owner’s Request for Director Review.

Respectfully submitted,

Dated: July 28, 2026

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that a true and correct copy of the foregoing was served on the Patent Owner as detailed below:

<i>Date of service</i>	July 28, 2026
<i>Manner of service</i>	Electronic Mail and Electronic Filing with the Board
<i>Documents served</i>	Authorized Response to Director Review Request
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